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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,833	02/12/2002	Dominique Bourel	065691-0260	8788
22428	7590	10/16/2003	EXAMINER	
SAUNDERS, DAVID A				
ART UNIT			PAPER NUMBER	
1644				

DATE MAILED: 10/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No. <b>980,833</b>	Applicant(s) <b>BOUREL et al</b>
Examiner <b>SAUNDERS</b>	Group Art Unit <b>1644</b>

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-29 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-29 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PTC Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a *single invention*.

Group I, claim(s) 1-9 and 25, drawn to Immunogloblin fractions.

Group II, claim(s) 10-24, drawn to methods of preparing immunoglobulin fractions.

Group III, claim(s) 26-29, drawn to methods of preparing/using an immunoglobulin as a pharmaceutical.

The inventions listed as Groups I-III does not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Since the IPEA has found prior art that anticipates or renders obvious the claims of, Groups I-III, applicant has not provided a special technical feature, which defines a contribution over the prior art, as required by PCT Rule 13.2, in order to provide for unity of invention

The examiner, furthermore, concurs with the IPEA examiner that the claims of Group I are not novel or are obvious. These claims encompass, for example, any affinity purified rabbit antiserum against DNP. The hapten DNP

has been employed as an exemplary hapten in numerous journal publications and in patent examples.

Also, the claims of Group I encompass any affinity purified rabbit antiserum against IgM. Such an antiserum would be conventionally used to prepare a secondary antibody reagent in immunofluorescent staining –e.g. to detect IgM auto antibodies.

The product of Group I is properly separated from the method of Group II, because, irrespective of the selecting features recited in step (d) of claim 10, it is considered that any method of affinity purification of specific antibodies against an antigen such as DNP, would inherently deplete antiserum reactivity against other non-self antigens.

The claims of Group III are properly separated from those of Groups I and II because as noted supra, Ig fractions prepared against DNP or IgM would have other uses.

No matter which Group is elected, the following election of species is stated:

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In order for more than one species to be examined, the appropriate additional examination fees must be paid. The species are as follows:

Immunoglobulin fractions (or the preparation or use thereof) directed to each of the following distinct species of antigen.

- A) IgM
- B) IgG F(ab')<sub>2</sub>
- C) DNP

The claims are deemed to correspond to the species listed above in the following manner:

Claim 9 corresponds to species C)

The following claim(s) to a plurality of distinct species: 1-8 and 10-29 are generic:

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: The antigens IgM, IgG F(ab')<sub>2</sub>, and DNP are distinct antigens; and the motivation to prepare an affinity purified antiserum against any one of these need not be the same as for preparing such an antiserum against the others.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at

least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Saunders, Ph.D., whose telephone number is (703) 308-3976. The examiner can normally be reached on Monday-Thursday from 8:00 a.m. to 5:30 p.m. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan, can be reached on (703) 308-3973. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196

D. A. Saunders:jmr  
October 9, 2003

*David A. Saunders*  
DAVID SAUNDERS  
PRIMARY EXAMINER  
ART UNIT 1644